REMARKS

Claims 1-53 are pending. Claims 1-9 have been elected with traverse. Claims 10-53 have been withdrawn from further consideration.

Claims 1-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,898,836 to Freivald et al. ("Freivald") in view of U.S. Patent No. 6,405,175 to Ng ("Ng"). Applicants respectfully traverse the rejections for the reasons set forth below.

§103 Rejections Are Overcome

A determination under §103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office (USPTO) has the initial burden under § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also *suggests the desirability* of the combination. M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be *clear and particular*, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In an even more recent decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be *particular* evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as recently stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

Applicants respectfully submit that Claims 1-5 and 7 are patentable over the cited references because the cited combinations fail to disclose or suggest the recitations of these claims.

Applicants' Claim 1 recites:

A method of updating information maintained at an intermediary web site on a computer network about items being auctioned at a plurality of remotely located auction sites on the computer network, wherein the information is displayable to users accessing the intermediary web site via the computer network, the method comprising the following steps:
obtaining auction item data that has changed since a previous time for auctions currently being conducted at the respective auction sites;
extracting keywords from the obtained auction item data; and
storing the extracted keywords, wherein each stored keyword is associated with an item currently being auctioned at a respective one of the plurality of remotely located auction sites, and wherein the stored keywords are searchable by users accessing the intermediary web site.
Claim 7 contains similar recitations.

The Action relies on the combination of Freivald and Ng in support of its rejection under §103. The Action states that Freivald discloses obtaining data that has changed, extracting keywords from the data, and storing the keywords. (Action, Page 3).

Applicants respectfully submit the rejections under §103 are improper because the primary reference Freivald fails to teach or suggest the steps of extracting keywords and storing the extracted keywords as defined in the present application and recited in Claim 1. Freivald describes a change detection tool that automatically retrieves and compares web documents for recent changes. (Freivald, Abstract). The Freivald change detection server **20** performs three basic functions: registers a web page document for change detection,

periodically re-fetches the document and compare for changes, and e-mails a change notice to the registered user if a change is detected. (Freivald, Col. 6, lines 47-54). In registering the web page document, a <u>user</u> selects which portions of the web page document are to be compared for changes. (Freivald, Col. 7, lines 9-12). The Action asserts that this user selection corresponds to "extracting keywords," as recited by Claim 1. (Action, Page 3). However, the present application discloses that an <u>agent</u> extracts keywords from information received. (Specification, Page 19, lines 28-29). The application further states that an agent is a program that gathers information or performs some service. (Specification, Page 19, lines 10-12). Thus, in the present application, extracting keywords is performed by an agent or program, which does not read on the user selection described by Freivald. As such, Freivald fails to disclose or suggest the step of extracting keywords, as recited by Claim 1.

Freivald also does not disclose or suggest the step of storing the extracted keywords. Freivald describes storing CRC's in a database **16** of change detection server **20**, and states that <u>a CRC is a condensed signature or fingerprint of a web page document</u>. (Freivald, Col. 6, lines 32-46). The Action asserts that this storing of CRC's corresponds to "storing the extracted keywords," as recited by Claim 1. (Action, Page 3). However, according to the present application, <u>each stored keyword is associated with an item currently being auctioned</u>. (Specification, Page 19, lines 32-33). Examples of keywords from the present application include "binoculars" and "stamps." (Specification, Pages 20 and 26). As such, the keywords of the present application do not include the CRC's described in Freivald. Further, even if CRC's were considered to be keywords, they are not <u>extracted</u>, as described in the present application, because Freivald discloses that the CRC's are <u>generated</u> based on a web page document. (Freivald, Col. 6, lines 32-46). Thus, Freivald does not teach or suggest the step of storing extracted keywords, as recited by Claim 1.

Moreover, the combination of Freivald and Ng does not appear to show the steps of extracting keywords and storing the extracted keywords. Because the primary and secondary references fail to teach or suggest *all* the recitations of Claim 1, and because the Action has set forth no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Freivald, Applicants respectfully request withdrawal of the present rejections of Claim 1, and the

claims dependent therefrom, under 35 U.S.C. §103. For at least the same reasons, Applicants respectfully request withdrawal of the present rejections of Claim 7 under 35 U.S.C. §103.

Applicants also submit that Claims 3-9 are independently patentable over the cited references because the cited combination of Freivald and Ng fails to disclose or suggest the recitations of these claims and the reasoning behind any modifications has not been established.

Applicants' Claim 6 as amended recites in part, "[a] method of updating information maintained at an intermediary web site on a computer network about items being auctioned at a plurality of remotely located auction sites...*wherein each auction site includes a data engine*..." Claims 3, 4, 5, and 9 similarly recite a data engine at each auction site.

The Action concedes that the combination of Freivald and Ng does not teach a data engine at each site. (Action, Page 4). Therefore, as required by the Federal Circuit, there must be clear and particular motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the primary reference to have a data engine at each auction site. Further, the prior art must suggest the desirability of such a modification. Applicants respectfully submit that the stated motivation for modification is insufficient.

The Action states that Freivald teaches a central data engine, and asserts that it would be obvious to have a data engine at every web site so that changes to the various sites could be reported immediately, rather than upon a later re-fetch of the site by the server. (Action, Page 4). However, having a data engine at each web site in the invention of Freivald would seem impractical and undesirable, as Freivald allows for change detection of the contents of any of a nearly infinite number of web sites. This would require a data engine at every web server where a user specifies that a document is located. In contrast, the present invention only monitors auction sites, of which there are a finite number, making a data engine at each auction site more feasible. As such, it would not be obvious to modify Freivald to include a data engine at each web site, and in fact, Freivald teaches away from such a modification.

The Action further supports having a data engine at each site by asserting that Freivald contemplates that the change detection tool can be located on a separate server and simply be called by the site's web server. (Action, Pages 4-5). The Action also states that such a modification would further reduce the time and effort for users to keep abreast of changes at a particular web site. (Action, Page 5). However, the fact that a change detection tool can be located on a separate server and called by a site's web server does not suggest the desirability of having a data engine at every site. Further, the stated motivation of reducing time and effort is not clear and particular, as it is unclear how having a data engine at each site would save the user any time or effort. As such, the stated motivation to modify Freivald is not sufficient to support the rejection under 35 U.S.C. §103.

Moreover, the combination of Freivald and Ng does not appear to show a data engine at each auction site, or provide the required motivation for modification. Because the references fail to teach or suggest *all* the recitations of Claim 6, and because the Action has set forth insufficient suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Freivald, Applicants respectfully request withdrawal of the present rejections of independent Claim 6, and claims dependent therefrom, under 35 U.S.C. §103. For at least the same reasons, Applicants respectfully request withdrawal of the present rejections of Claims 3, 4, and 5 under 35 U.S.C. §103.

Conclusion

In view of the above, it is respectfully submitted that this application is in condition for allowance, which action is respectfully requested.

It is not believed that an extension of time and/or additional fee(s) are required. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to our Deposit Account No. 50-0220.

Respectfully submitted,

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